

REMARKS

Claims 24-34 were pending in this application when the present Office Action was mailed (December 28, 2005), with claims 30-34 withdrawn from consideration. In this response, claims 24, 25, and 29-31 have been amended, and no claims have been added. Accordingly, claims 24-34 are currently pending with claims 30-34 withdrawn from consideration.

In the December 28, 2005 Office Action, all of the pending claims were rejected. More specifically, the status of the application is as follows:

- (A) Claims 25 and 29 stand rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite;
- (B) Claims 24, 25, and 27-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,690,705 to Holmes et al ("Holmes");
- (C) Claims 24 and 27 stand rejected on the ground of non-statutory obviousness-type double patenting over claim 1 of U.S. Patent No. 6,736,869; and
- (D) Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Holmes in view of U.S. Patent No. 5,965,679 to Godschalx et al ("Godschalx").

As a preliminary matter, the undersigned attorney wishes to thank the Examiner for engaging in a telephone interview on March 10, 2006. During the telephone interview, the Examiner and the applicant's representative discussed the claimed subject matter and the cited reference – Holmes. The Examiner agreed to reconsider the rejections in view of the cited references. The following remarks reflect and expand upon the discussion during the March 10 telephone interview. As such, the applicant requests that this paper also constitutes the applicant's Interview Summary.

A. Response to the Section 112 Rejection

Claims 25 and 27 were rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. Claims 25 and 27 have been amended to address the Examiner's concern.

Accordingly, the Section 112, second paragraph, rejections of claims 25 and 27 should be withdrawn.

B. Response to the Section 102(b) Rejection

Claims 24, 25, and 27-29 were rejected under 35 U.S.C. § 102(b) as being anticipated by Holmes. Even though applicant respectfully disagrees with the basis of the rejections, applicant has amended claim 24 to further clarify the claimed subject matter. For the reasons discussed below, claims 24, 25, and 27-29 are allowable over Holmes. Accordingly, the Section 102(b) rejections of these claims should be withdrawn.

Claim 24 is directed to a method for forming a textured planarizing pad. The method includes floating a film of a support material on a supporting liquid and separating a planarizing pad material into discrete elements. The method further includes distributing the discrete elements in and/or on the support material floated on the supporting liquid, and drawing the support material and the discrete elements from the supporting liquid by engaging the support material with a backing material and moving the backing material away from the liquid.

Holmes discloses a method for making precisely shaped composites (Abstract). Holmes discloses feeding a binder precursor 12 onto a production tool 16 having cavities in a carrier web (column 4, lines 26-30, Figure 6). The carrier web can contain a thin, water-soluble layer before receiving the binder precursor 12 (column 5, lines 16-18). The binder precursor 12 is then exposed to an energy source 25 to solidify (column 4, lines 37-40). The solidified binder precursor 12 can then be removed from the production tool 16 to form binder material 26 by dissolving the water-soluble layer with water (column 4, lines 42-45).

Claim 24 is allowable over Holmes because Holmes fails to teach or suggest each and every feature of claim 24. For example, assuming, for the sake of argument, that Holmes' water-soluble layer corresponds at least in part to the support material of claim 24, Holmes does not disclose "floating a film of a support material on a supporting liquid," of claim 24. Instead, Holmes discloses applying water to dissolve the water-soluble layer carried by the production tool. As such, the water-soluble layer cannot be floated on the applied water because the layer would be dissolved after water is applied. As a result, Holmes does not disclose a support

material floated on a supporting liquid. Consequently, Holmes cannot disclose "distributing the discrete elements in and/or on the support material floated on the supporting liquid" of claim 24. Accordingly, the Section 102(b) rejection of claim 24 should be withdrawn. The Section 102(b) rejections of claims 25 and 27-29 should also be withdrawn because these claims depend from claim 24, and also because these claims contain additional features.

C. Response to Non-statutory Double Patenting Rejection

Claims 24 and 27 were rejected on the ground of non-statutory obviousness-type double patenting over claim 1 of U.S. Patent No. 6,736,869. For this rejection, Holmes was cited for teaching the step of engaging the support material with a backing material and moving the backing material away from the support liquid. As discussed above, Holmes does not teach or suggest "floating a film of a support material on a supporting liquid." As a result, Holmes cannot teach engaging the support material with a backing material and moving the backing material away from the support liquid because there is no support liquid in Holmes. Accordingly, the cited references do not support a *prima facie* case of obviousness because the cited references fail to teach or suggest each and every feature of claims 24 and 27. Therefore, the non-statutory obviousness-type double patenting rejections of claims 24 and 27 should be withdrawn.

D. Response to the Section 103(a) Rejection

Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Holmes in view of Godschalx. As discussed above, Holmes fails to teach or suggest each and every feature of claim 24, and Godschalx fails to fill this void. More specifically, Godschalx was cited for the proposition that this reference teaches depositing a multilayer film using a Langmuir-Blodgett technique. Godschalx, however, does not disclose or suggest floating a Langmuir-Blodgett film on a texture polishing pad and distributing discrete elements in and/or on the Langmuir-Blodgett film. As a result, claim 26 is allowable over Holmes and Godschalx because claim 26 depends from claim 24, and also because claim 26 contains additional features. Accordingly, the Section 103(a) rejection of claim 26 should be withdrawn.

E. Examination of Withdrawn Claims

Claims 30-34 were withdrawn from consideration. Each of these claims includes features described above with reference to claim 24 and/or other claims, or depends from such claims. Claim 24 is generic to these claims and accordingly, these withdrawn claims should be considered and, upon an indication that claim 24 is allowable, these claims should be allowed.

F. Conclusion

In view of the foregoing, the pending claims comply with 35 U.S.C. § 112 and patentably define over the applied art. The applicant respectfully requests reconsideration of the application and a mailing of a Notice of Allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned representative at (206) 359-6038.

Date: 3/28/06

Respectfully submitted,

Perkins Coie LLP



Chen Liang
Registration No. 51,945

Correspondence Address:

Customer No. 25096
Perkins Coie LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 359-8000